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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,869	12/08/2000	Georgia L. Helmer	5051-473	3142

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EXAMINER

MARVICH, MARIA

ART UNIT

PAPER NUMBER

1633

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 09/733,869	Applicant(s) HELMER ET AL.	
Examiner Maria B. Marvich, PhD	Art Unit 1633	

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 01 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 1 and 4-18.
Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

Continuation of 5. Applicant's reply has overcome the following rejection(s): Applicants' amendment has overcome the rejections under 35 USC 112, second paragraph.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants traverse the rejection under 35 USC 102(e) as anticipated by Baszczynski et al. Applicants argue that in the methods of Baszczynski et al, there must be two-non identical target ssites in the plant genome and the sites flanking the DNA of interest must also be non-identical to recombine with the two-nonidentical sites in the plant genome.

Applicants arguments filed 2/1/06 have been considered but are not persuasive. According to Baszczynski et al, the cell is transformed with a Agrobacterium replicon with " a first target stie for a site-specific recombinase, a viral replicon, said DNA sequence of interest, and a second target site for recombinase in a direct repeat with said first target site, wherein said first and said second target sites are identical" (paragraph 0024). Paragraph 0027 teaches that this DNA of interest integrates into the genome and then excises using the identical first and second sites. The excised circle than integrates through targeted integration with a corresponding sequence. The claims do not occlude that the second integration occures through a double cross over event. The claims only recite that the target site on the chromosome is flanked by a single recombination site. This only limits the sequence on one side of the DNA to a single recombination site but does not limit the target site to only one recombination site.

Continuation of 13. Other: Applicants traverse the finality of the office action mailed 11/1/05 on the basis that it contains an improper final rejection. Applicants argue that the rejection under 35 USC 102 (e) as anticipated by Baszczynski et al was not previously disclosed.

Applicants arguments filed 2/1/06 have been considered but are not persuasive. The rejection under 35 USC 102(e) by Baszczynski et al was necessitated by applicants amendments filed (see MPEP 706.07(a)). In the instant case, the claims were amended to recite that the nucleotide of interest was flanked by a pair of identical recombination sites and that the nucleotide of interest randomly inserts into the chromosome, generates an excision circle and then inserts into said chromosomal site. The changee in scope of the claims has necessiated the new rejection. Therefore, the finality of the office action is maintained.

Furthermore, the substitute submission of figure 8 has not generated an image that is acceptable for publication. The image is still too dark to see any details.



DAVE TRONG NGUYEN
SUPERVISORY PATENT EXAMINER